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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,248	03/30/2004	Plinio Pimentel	3408.2.8	4822
21552 7590 04/15/2010 AUSTIN RAPP & HARDMAN 170 South Main Street, Suite 735 SALT LAKE CITY, UT 84101				
EXAMINER				
OKEKE, EZUNNA				
ART UNIT		PAPER NUMBER		
2432				
NOTIFICATION DATE		DELIVERY MODE		
04/15/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptocorrespondence@austin-rapp.com

### Office Action Summary

**Application No.**

10/813,248

**Applicant(s)**

PIMENTEL, PLINIO

**Examiner**

IZUNNA OKEKE

**Art Unit**

2432

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/23/2010 has been entered.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 18-20 recites "computer readable medium". There is no definition of "computer readable medium" in the specification that limits the term to hardware. Given a broad reasonable interpretation, the "computer readable medium" can be a signal and is non statutory. Therefore, claims 18-20 are directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5-6 and 8-20 are rejected under 35 U.S.C. 102(b) as being anticipated by McBrearty et al. (US-7647402)

a. Referring to claim 1, 13, 15 and 18:

Regarding claim 1 and similar claims 13, 15 and 18, McBrearty teaches in a computing device, a method for protecting sensitive files from unauthorized access Col 2, Line 45-56.... Protecting sensitive files from unauthorized access), comprising: detecting a connection of the computing device to an electronic device; accessing an authorized connection list (Col 5, Line 29-43... connection of a computing device to a database server based on an authorized list); determining whether the connection is identified in the authorized connection list; and if the connection is not identified in the authorized connection list (Col 5, Line 56-63... when a file request is made, a determination is made if the connection was authenticated based on the authorized list): accessing sensitive file information which identifies at least one sensitive file stored on the computing device, wherein the sensitive file is not identified until after the connection has been identified as not being in the authorized connection list (Col 5, Line 30-63.... a connection request is first made to a file server and the requester is checked against an authorized list, after that, a file is requested and based on the authentication (authorized list), access to file is allowed or prevented);\_and preventing access to the at least one sensitive file identified by the sensitive file information by performing an access prevention task after the connection is not identified in the authorized connection list, wherein the at least one sensitive file continues to be stored on the computing device (Col 6, Line 10-19.... preventing access to the file by performing a prevention task if the

requester is not authorized/identified (by the authorized list) and the file continues to be stored on the database).

a. Referring to claim 2, 16 and 19:

Regarding claim 2, McBrearty teaches the method of claim 1, wherein if the connection is not identified in the authorized connection list the method further comprises: detecting termination of the connection; and if the computing device does not have any other unauthorized connections, restoring access to the at least one sensitive file identified by the sensitive file information (Col 6, Line 21-26.... following termination of the session, restoring the server to normal operations).

a. Referring to claim 3:

Regarding claim 3, McBrearty teaches the method of claim 1, wherein the connection occurs via a computer network (Col 3, Line 64 thru Col 4, Line 19).

a. Referring to claim 5:

Regarding claim 5, McBrearty teaches the method of claim 1, wherein the connection is a direct connection (Col 5, Line 30-33... direct system to database connection).

a. Referring to claim 6, 8, 17 and 20:

Regarding claim 1, McBrearty teaches the method of claim 1, wherein the access prevention task comprises locking the at least one sensitive file (Col 6, Line 10-19.... Access prevention task such as renaming the file, hiding the file or moving the file to another location)

a. Referring to claim 9 and 10:

Regarding claim 1, McBrearty teaches the method of claim 1, wherein the sensitive file information is a reference to a directory in which the at least one sensitive file is stored (Col 3, Line 58-64).

a. Referring to claim 11 and 12:

Regarding claim 1, McBrearty teaches the method of claim 1, wherein the authorized connection list comprises a list of at least one authorized network (Col 3, Line 64 thru Col 4, Line 11.... authorization for a network and type such as internet web connection).

a. Referring to claim 14:

Regarding claim 14, McBrearty teaches the method of claim 13, further comprising: providing the authorized connection list; providing the sensitive file information; and transmitting the authorized connection list and the sensitive file information to the plurality of computing devices via the enterprise network (Col 5, Line 29-42.... Providing the connection list and protected file).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over McBrearty et al. (US-7647402), and further in view of Elliott et al. (US-20030056095).

a. Referring to claim 4:

Regarding claim 4, McBrearty teaches the method of claim 3.

McBrearty does not teach the connection network as a wireless network and the device as a mobile device. However, Elliott teaches a method of securing encrypted files from unauthorized access where the connection is made through a wireless network and by a mobile device (See Elliott, Para 22). Therefore, it would have been obvious to modify McBrearty's method and invention to include support for a wireless network and a mobile device as the client as taught by Elliott for the purpose of improving the system by incorporating wireless devices as client device making request for access to files on the sever.

**8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over McBrearty et al. (US-7647402), and further in view of Kung (US-5265159)**

a. Referring to claim 7:

Regarding claim 7, McBrearty teaches performing an access prevention task on a sensitive file when an unauthorized access is made to the file. McBrearty does not teach one of the access prevention tasks as encrypting the sensitive file. However, deletion of sensitive file by encrypting the files to prevent unauthorized access to the file is well known in the art. For instance, Kung discloses an access prevention task of deleting a file by encrypting the file to prevent unauthorized access to it (See Kung, Abstract). Therefore, one of ordinary skill would be motivated to modify McBrearty's access prevention task to include the task of encrypting the file to prevent access to the file thereby protecting the file from unauthorized access.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IZUNNA OKEKE whose telephone number is (571)270-3854. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IZUNNA OKEKE/  
Examiner, Art Unit 2432

/Jung Kim/  
Primary Examiner, AU 2432